

REMARKS

Claims 1-15 are all the claims pending in the application. Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Adachi (US 5,151,795). Claims 3-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adachi in view of Ohara (US App. 2001/0038707).

By this Amendment, Applicant is amending claims 1, 2, 5, 7, 11 and 15, and is canceling claims 3, 4, 6 and 12.

Preliminary Remarks

The Examiner states that it is unclear as to whether the number "1" in claim 6 means that no compression is taking place. Applicant submits that the number "1" does mean that no compression is taking place.

§102 Rejection

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Adachi (US 5,151,795).

Amended claims 1 and 2 recite limitations found within claims 3 and 4. Because the Examiner has acknowledged on page 6 of the Office Action dated September 19, 2005 that Adachi fails to teach all of the elements of claims 3 and 4, the arguments regarding amended claims 1 and 2 will be limited to the §103 rejection. Applicant submits that the amendments should be entered because they include subject matter previously pending before the Examiner and should therefore raise no new issues. The amendments also place the application in condition for allowance for the reasons set forth below.

§103 Rejection

Claims 3-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adachi in view of Ohara (US App. 2001/0038707). Applicant respectfully traverses.

The Examiner argues that Adachi teaches irreversible compression of image signals. While Adachi discusses irreversible compression in the background of the invention, Applicant submits that the reference teaches away from the use of irreversible compression in the reference. The embodiment of the background and the embodiments of the reference cannot be combined without support. *Ex Parte Kramer*, 18 U.S.P.Q.2d 1415, 1416 (Fed. Cir. 1991). While not specifying the type of compression used, the process disclosed in Adachi appears to be reversible compression. Adachi also states the irreversible compression should not be used because it causes deteriorated data reproduction and image quality. See Adachi column 1, lines 39-51. The Examiner acknowledges that Adachi does not expressly disclose reversible compression, and due to the preceding argument, Adachi cannot anticipate the amended claims 1 and 2 as it does not teach all aspects of the invention.

Further, the Examiner asserts that the motivation to combine Adachi and Ohara stems from the fact that both disclosures relate to compression of x-ray images and compression techniques well known in the art. Further, the Examiner argues that Ohara teaches the reversible compression of x-ray images. For two references to render an invention obvious, there must be a suggestion to combine the references, and each element of the invention must be taught by the references. Ohara, along with Adachi, tends to teach away from irreversible compression because irreversible compression causes degradation of the data and images. Because there is no

suggestion that irreversible compression should be used in either Adachi or Ohara, the combination thereof cannot render the present invention obvious. Also, since neither Adachi nor Ohara teach all aspects of amended claims 1 and 2, the references, either individually or in combination with one another, cannot render the claimed invention obvious. Amended claims 1 and 2 are patentable over the applied art.

Claims 8-11 and 13-14 are patentable at least by virtue of their dependency from claim 1, while, claims 5 and 7 are patentable at least by virtue of their dependency from claim 2.

Applicant further submits that claims 8 and 9 are independently patentable. Claims 8 and 9 specify certain compression ratios. The Examiner contends that this is a matter of design choice. To the extent that selection of an individual compression rate may be a matter of design, the references do not teach the inter-relationships of the different compression types for the different images in conjunction with specific ratios. Therefore, claims 8 and 9 are patentable.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 10/044,962

ATTORNEY DOCKET NO. Q66581

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Respectfully submitted,

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